

REMARKS

Applicant has carefully studied the Office Action of May 6, 2004 and offers the following remarks in response thereto.

Claims 61-64, 66, 68-71, 73-75, 77-79, 81, 83-86, 88-94, 96, 98-100, 103-105, and 107-109 were rejected under 35 U.S.C. § 102(e) as being anticipated by White et al. (hereinafter "White"). Applicant respectfully traverses. For a reference to be an anticipatory reference, the reference must show each and every claim element. Furthermore, the elements of the reference must be arranged as claimed. MPEP § 2131. These requirements represent a strict standard.

In the previous response, Applicant noted that claims 107-109 depend from claim 106, which was not rejected under § 102(e) as being anticipated by White. It is virtually impossible for a dependent claim to be anticipated when the Patent Office admits that the independent claim from which the dependent claim depends is not anticipated. As such, it is improper for claims 107-109 to be rejected under 35 U.S.C. § 102(e) when claim 106 from which they depend is not so rejected. The Patent Office, in the present Office Action, continues to admit that White does not teach a computer readable medium (see Office Action of May 6, 2004, page 6, lines 5-6). The Patent Office does, in the Response to Arguments section, take an inconstant position stating in section A that the computer readable medium reads on White's internet gateway router of Figure 3. Applicant traverses this inconsistency. Applicant requests clarification as to what the Patent Office's position is on this subject.

If the Patent Office ultimately decides that it wishes to construe the internet gateway router as the computer readable medium, Applicant respectfully traverses this interpretation as not being an interpretation that falls within the broad reasonable scope someone of ordinary skill in the art would give "computer readable medium."

Applicant only continues to address this point because the Patent Office maintains an inconsistent position, and Applicant wishes to understand what position the Patent Office is adopting.

Claim 61 recites, "means for receiving *a packet based indication* that the attempted communication session was not completed" The Patent Office opines, both in the body of the Office Action and in the Response to Arguments section that this element is taught by White at col. 21, lines 61-64. While col. 21, lines 61-64 do indicate that the common channel signaling system determines that the call cannot be completed such as because of a busy or no answer

situation, there is no teaching or suggestion that the indication received by the common channel signaling system is a *packet based* indication that the communication session was not completed. The Patent Office's continued reliance on this section of the reference has not cured the underlying problem with the Patent Office's position. The reference does not indicate that this is a packet based indication and thus the reference does not teach the claim element. For example, the common channel signaling system can be entirely within the LEC 1, the EO 129 or the like, in which case there is no packet based indication that the communication session was not completed. The Patent Office cannot read this element into the reference in an anticipation rejection. Further, the Patent Office has not shown where the reference suggests such an element in an obviousness analysis. Since the reference does not teach the claim element, the reference cannot anticipate the claim.

Claim 61 also recites, "receiving means for receiving at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session" The Patent Office, in the body of the Office Action and in the Response to Argument section, opines that this is disclosed by White at col. 21, line 64 - col. 22, line 7, and points to Internet 106. However, as explained in col. 22, lines 1-7, VMS 125 informs the calling party that the line was busy. Figure 12 makes it abundantly clear that communication between the calling party and VMS 125 does not pass through Internet 106 and thus does not constitute a packet based message providing an indication of a treatment. The presence of Internet 106 in Figure 12 is irrelevant to the determination that the VMS 125 sends a packet based signal because Internet 106 is not positioned between VMS 125 and the calling party. As the claim recites receiving means for receiving at the calling party a packet based message providing an indication of a treatment, and the VMS 125 to calling party communication is not packet based, the reference does not show the claim element. Since the reference does not show a claim element, the reference cannot anticipate the claim.

The Patent Office, in the Response to Arguments section, goes on to opine that this element is taught at col. 22, lines 15-33. Col. 15, lines 15-33 do describe the situation where the VMS 125 sends a message to VMS 127, presumably over the Internet 106. However, this is not what is claimed. The claim recites, "receiving means for receiving at the calling party's communication device a packet based message. . . ." VMS 127 is not the calling party's

communication device, and is specifically associated with the called party Z. Thus, the fact that a message may travel from VMS 125 to VMS 125 over Internet 106 is not pertinent to the evaluation of the claim.

Independent claims 70, 76, 85, 91, and 100 recite similar elements. For example, claim 70 recites, "providing means providing at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session" Claim 76 recites, "receiving means for receiving at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session." Claim 85 recites, "providing means for providing at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session" Claim 91 recites, "receiving at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session." Claim 100 recites, "providing at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session" Thus, each claim recites the packet based message providing an indication of the attempted communication session. As White's VMS 125 does not provide a packet based message to the calling party's device, the claims are not anticipated. In light of this fact, Applicant requests withdrawal of the § 102(e) rejection of claims 61, 70, 76, 85, 91, and 100 at this time.

Claims 62-64, 71, 77-79, and 86 depend from these independent claims and thus are not anticipated at least for the same reasons. Applicant further traverses this rejection on the grounds that the passage cited by the Patent Office to support the rejection of claims 62-64, 71, 77-79, and 86 is not part of the system described by White. Specifically, White, at col. 3, lines 36-49, describes Creswell's system (see White, col. 3, line 17). Applicant reminds the Patent Office that the elements of the reference must be arranged as claimed. MPEP § 2131. Creswell's system forms no part of the White system cited elsewhere by the Patent Office, and thus the passage describing Creswell's system is not arranged relative to the rest of White's system, and is not arranged as claimed. To this extent, the reference cannot anticipate the claims. Applicant previously presented this argument and the Patent Office ignored it. The Patent Office is not allowed to rearrange the elements of the reference in an anticipation analysis. Since it is clear

that the Patent Office is mixing and matching components from disparate systems, it is clear that White does not anticipate these claims.

Further, Applicant respectfully traverses on the ground that the cause value recited in the claims is not inherent in White or Creswell's system. Specifically, for an element to be inherent, the element must necessarily be present in the reference. MPEP § 2112. To the extent that the attempt to establish the phone call may fail for numerous reasons (congestion, busy, etc.), there is not necessarily a cause value sent to the calling party's communication device. The only thing that the calling party's communication device necessarily receives is an indication that the call was not completed. To this extent, the element is not inherent, and the claims are not anticipated. The Patent Office, in the Response to Arguments section, responds to this with the statement, "the examiner maintains that the cause value recited in the claims is inherent in whites [sic] VMS." This is insufficient as a matter of law. The Patent Office has the burden of establishing that the Applicant is not entitled to a patent. Mere assertions are insufficient to establish such facts. Applicant has set forth the standard for inherency and explained why the reference does not necessarily have a cause value. The Patent Office's asserted response is insufficient to overcome this argument. If the Patent Office wishes to maintain this position, the Patent Office must prove, through evidence, that someone of ordinary skill in the art, upon reading White, would understand that White necessarily has cause values to work. As Applicant has explained, there are situations where no cause value is generated, and thus White does not necessarily have cause values and does not inherently have cause values. Since the Patent Office has not shown where the cause values are in the reference and has not proven that the cause values must necessarily be present, it is clear that the Patent Office has not proven that the reference teaches the claim element under the strict standards of an anticipation analysis. Absent such proof, the Patent Office cannot reject these claims on this basis. Applicant requests withdrawal of the rejection on this basis, or at a minimum a responsive presentation of facts from the Patent Office.

Claims 66 and 81 also depend from the independent claims, and are not anticipated at least for the same reasons that the underlying independent claims are not anticipated.

Claims 68, 74, 83, 89, 90, 98, and 104 also depend from the independent claims and are not anticipated at least for the same reasons that the underlying independent claims are not anticipated. Applicant further traverses the Patent Office's assertion that the claim element of

the version is provided in White at col. 21, line 64 - col. 22 line 7. Applicant has studied the cited passage and finds no teaching or suggestion that a version of the treatment is supplied. While there is a prompt to deliver a message and an indication of the cost, there is nothing that indicates that, e.g., v. 1.2 of the treatment is provided. To this extent, the reference fails to show a claim element, and the claims are not anticipated. In the Response to Arguments section, the Patent Office explains that col. 22, lines 3-12 teach a multimedia version. Applicant traverses this assertion. Applicant has studied the cited section and finds no reference to multimedia version. The passage discusses a prompt to leave a message and then the steps that can be taken for the message to be left, but there is no discussion of multimedia or different types of versions in the passage. Since the Patent Office's proof is deficient, the claims are allowable.

Claims 69, 75, 84, 99, and 105 also depend from the independent claims and are not anticipated at least for the same reasons that the underlying independent claims are not anticipated. Applicant further traverses the Patent Office's assertion that the claim element is taught by White at col. 22, lines 3-12. The claim recites a multimedia version of the treatment. The cited passage indicates that an audio prompt is played. Nowhere is there an indication that the audio prompt is a "multimedia treatment" as that term is interpreted by someone of ordinary skill in the art. To this extent, the claim element is not shown, and the claims are not anticipated. In the Response to Arguments section, the Patent Office explains that col. 22, lines 3-12 teach a multimedia version. Applicant traverses this assertion. Applicant has studied the cited section and finds no reference to multimedia version. The passage discusses a prompt to leave a message and then the steps that can be taken for the message to be left, but there is no discussion of multimedia or different types of versions in the passage. Since the Patent Office's proof is deficient, the claims are allowable.

Claims 92-94 and 101 also depend from the independent claims and are not anticipated at least for the same reasons that the underlying independent claims are not anticipated. Applicant further traverses this rejection on the grounds that the passage cited by the Patent Office to support the rejection is not part of the system described by White. Specifically, White, at col. 4, lines 13-28, describes Jordan's system (see White, col. 4, line 5). Applicant reminds the Patent Office that the elements of the reference must be arranged as claimed. MPEP § 2131. Jordan's system forms no part of the White system cited elsewhere by the Patent Office, and thus the

passage describing Jordan's system is not arranged relative to the rest of White's system and the elements are not arranged as claimed. To this extent, the reference cannot anticipate the claims.

Applicant previously presented this argument and the Patent Office ignored it. The Patent Office is not allowed to rearrange the elements of the reference in an anticipation analysis. Since it is clear that the Patent Office is mixing and matching components from disparate systems, it is clear that White does not anticipate these claims.

Applicant previously further traversed the assertion that the passage at col. 4, lines 13-28 describes the recited cause value. Applicant has studied the passage and finds nothing that corresponds to the cause value therein. Applicant previously requested that the Patent Office identify with particularity what element is being construed as the cause value. The Patent Office did not do so. Absent a better explanation by the Patent Office, Applicant is entitled to a patent.

Claims 96 and 103 also depend from the independent claims and are not anticipated at least for the same reasons that the underlying independent claims are not anticipated.

In light of the failure of the references to show the claim elements recited in the claim, Applicant requests withdrawal of the § 102(e) rejection of claims 61-64, 66, 68-71, 73-75, 77-79, 81, 83-86, 88-94, 96, 98-100, 103-105, and 107-109 at this time.

Claims 65, 67, 69, 72, 75, 80, 82, 84, 87, 95, 97, 99, 102, 105, 110, and 117 were rejected under 35 U.S.C. § 103 as being unpatentable over White in view of Creswell. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element is located in the combination of references. MPEP § 2143.03. Further, where the Patent Office advances a motivation to combine two references, the Patent Office is obligated to provide objective evidence supporting the motivation to combine. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Initially, Applicant notes that nothing in Creswell cures the deficiencies of White. Since the references individually still do not show the packet based message, the combination of references cannot teach or suggest the packet based message. Since the combination does not teach or suggest a claim element, the Patent Office has not established *prima facie* obviousness.

Applicant further traverses the rejection on the grounds that the Patent Office has not provided the requisite objective evidence to support the combination as required by *Dembiczak*. The Patent Office opines that the reason to incorporate alternate languages is to provide the capability for the system to operate in different languages. However, the Patent Office's

motivation amounts to nothing more than a tautology. To this extent, the combination is improper, and the Patent Office has failed to establish *prima facie* obviousness.

Applicant previously argued this point and the Patent Office has not responded. The Federal Circuit has laid out the rules under which the Patent Office may issue obviousness rejections and the Patent Office is not free to ignore them. The Patent Office must present actual evidence or the combination is improper. Since the Patent Office has not presented any evidence, the combination is improper, and the claims are allowable.

Claims 69, 75, 84, 99, and 105 deserve special mention in that they recite a multimedia treatment. As explained above, the passage at White col. 22, lines 3-12 teaches an audible prompt; this audible prompt is not the same thing as the recited multimedia treatment, and no one of ordinary skill in the art would equate the two elements. To this extent, these claims recite an element which the Patent Office has not shown, and these claims are independently patentable over the rejection.

Claims 106-109, 111-114, 116, and 118-120 were rejected under 35 U.S.C. § 103 as being unpatentable over White. Applicant respectfully traverses. The standard for obviousness is set forth above. Further, where obviousness is based on a single reference, the Patent Office must present actual evidence as to the motivation to modify the reference. Absent such evidence, it is improper to modify the reference. *In re Dembiczak*. In the present case, the Patent Office has not provided the actual evidence supporting the motivation to modify White to show the admittedly missing claim elements, and thus the modification is improper. Since the claim elements are admittedly missing from White absent modification, White does not establish obviousness and the claims are allowable.

As indicated in the anticipation rejection, White does not teach or suggest that the message is a packet based message. To this extent White cannot establish *prima facie* obviousness for these claims.

Claim 107-109 deserve special mention in that they recite the cause value. As explained above, White does not teach or suggest this cause value and the claims are independently patentable over the rejection. This was previously argued and the Patent Office has not responded. The burden is on the Patent Office to prove Applicant is not entitled to a patent. Having presented this argument, the Patent Office is obligated to respond to show why Applicant

is not entitled to a patent. Having failed to respond to the argument, the Patent Office has not met its burden, and Applicant is entitled to a patent.

Claim 109 deserves further mention in that the address cited by the Patent Office (White, col. 7, lines 21-27) is the address of a gateway router to establish a phone call over the Internet, not an address of a message. Thus, the passage does not support the Patent Office's rejection and claim 109 is independently patentable over the rejection. This position was previously argued and the Patent Office has not responded. The burden is on the Patent Office to prove Applicant is not entitled to a patent. Having presented this argument, the Patent Office is obligated to respond to show why Applicant is not entitled to a patent. Having failed to respond to the argument, the Patent Office has not met its burden and Applicant is entitled to a patent.

Claim 113 recites that the indication includes the particular version of the treatment. As explained above, White does not teach the particular version of the treatment being included as part of the indication and thus, this element is not shown by the Patent Office. Since the element is not shown, the claim is independently patentable over the rejection. This position was previously argued and the Patent Office has not responded. The burden is on the Patent Office to prove Applicant is not entitled to a patent. Having presented this argument, the Patent Office is obligated to respond to show why Applicant is not entitled to a patent. Having failed to respond to the argument, the Patent Office has not met its burden, and Applicant is entitled to a patent.

Claim 114 recites the multimedia treatment. As explained above, White does not teach this element with its audible prompt. To this extent, the element is not shown and the claim is independently patentable over the rejection. This position was previously argued and the Patent Office has not responded. The burden is on the Patent Office to prove Applicant is not entitled to a patent. Having presented this argument, the Patent Office is obligated to respond to show why Applicant is not entitled to a patent. Having failed to respond to the argument, the Patent Office has not met its burden, and Applicant is entitled to a patent.

Applicant further notes that claim 115 is never rejected by the Patent Office. Applicant noted this in the previous response, and still the claim is not addressed anywhere in the Office Action. Since claim 115 has not been rejected by the Patent Office, claims 116-120 which depend therefrom cannot be rejected by the Patent Office. In light of this, addressing the rejection of claims 116-120 would be premature. Furthermore, since the Patent Office has not provided any analysis of claim 115, it is improper to make the present rejection final. Applicant

requests withdrawal of the finality of the rejection and a new Office Action that addresses claim 115.

Applicant requests reconsideration of the rejection in light of the remarks presented herein. The references of record do not show a packet based message being delivered to the calling party's communication device. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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